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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/266,936	03/12/1999	PETRI SILENIUS	1562.0110000	6421

7590

02/04/2002

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EXAMINER

KRUER, KEVIN R

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 02/04/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/266,936

Applicant(s)

SILENIUS

Examiner

Kevin R Kruer

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 24 January 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ they raise the issue of new matter (see Note below);
(c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: NONE.

Claim(s) objected to: NONE.

Claim(s) rejected: 1-16.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Advisory Action

Applicant's after final amendments (Paper #14) filed January 24, 2002, and its supplemental reply (Paper #15) filed January 25, 2002 have been fully considered but they are not persuasive. Furthermore, the proposed amendments will not be entered because (1) they raise new issues that would require further search and/or consideration; (2) they raise the issue of new matter; (3) they are not deemed to place the case in better form for appeal by materially reducing or simplifying the issues for appeal, and (4) they present new claims without canceling a corresponding number of finally rejected claims.

The proposed amendments would require further search and/or consideration in that the newly proposed claims would require that the fine paper be coated with a coating containing calcium oxalate. Such a limitation was not previously required.

The proposed amendment raises the issue of new matter in that there is no support for the proposed "by weight" limitation of claim 2.

The proposed amendment is deemed not to place the case in better form for appeal because the rejection of paragraph #6 (Paper #11) and the objection to claim 10 are not addressed. Furthermore, the rejections of Paragraphs #7 and 13 would not be overcome by Applicant's proposed amendments.

Applicant argues that Matsuda, Post, and Hampl are not in the same field of endeavor as Carno. Specifically, Applicant argues that the papers of Matsuda, Post, and Hampl do not contain ligneous or mechanical pulp as taught in Carno. The examiner respectfully disagrees with Applicant's narrow interpretation of analogous

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fields of endeavor. The examiner maintains the position that all the references are directed to the paper industry, and thus are analogous art.

Applicant also argues that the fine papers taught in Matsuda, Post, and Hampl are not susceptible to yellowing. However, counsel's argument does not take the place of evidence. Furthermore, Carno teaches that calcium oxalate is useful as a paper pigment. The courts have held that the substitution of one equivalent component for another is not necessary to render such substitution obvious. In re Fout, 675 F2d, 297, 213 USPQ 532 (CCPA 1982).

Applicant further argues that the finality of Paper #11 should be removed because (1) the action contained a new 35 U.S.C. 112, first paragraph rejection of claim 16, and (2) the new rejections based upon Post and Hampl were not necessitated by amendment. However, the first paragraph rejection was necessitated by amendment. Specifically, applicant amended the claim to read that the percentages were based on "total weight." There was no support for such an amendment. With respect to the new rejections based upon Post and Hampl, the examiner maintains the position that applicant's amendment necessitated the new rejections. Specifically, Applicant amended the claim to read on "fine paper," which is much narrower than the previous language that read "paper or cardboard."

NOTE: If the supplemental reply filed January 25, 2002 (Paper #15) was filed separately, it would be sufficient for overcoming the rejection of Paragraph #11.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 703-305-0025. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 703-308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



KRK
January 31, 2002



Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700